

Hearing:
February 22, 2000

Paper No. 26
DEB

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 6/21/00
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Southwestern Bell Telecommunications, Inc.
v.
Patrick Vernon Palmer

Opposition No. 107,647
to application Serial No. 75/133,153
filed on July 12, 1996

J. David Wharton and Constance M. Jordan of Shook Hardy &
Bacon, L.L.P. for Southwestern Bell Telecommunications, Inc.

Russell J. Egan for Patrick Vernon Palmer.

Before Simms, Quinn and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Patrick Vernon Palmer has filed an application for
registration of the mark "FREEFONE" in the format shown below:

Freefone

for "advertising services, namely providing advertising space
on public telephones and telephone booths, and rental of

advertising space on public telephones and telephone booths," in International Class 35.¹

Southwestern Bell Telecommunications, Inc., a Delaware corporation, filed a timely notice of opposition on May 30, 1997. As grounds for opposition, opposer asserts prior use of the following registered trademarks:

- Reg. No. 1,122,266 of the mark "FREEDOM PHONE" for "wireless telephones, wireless telephone receiving stations, and wireless telephone base stations."
- Reg. No. 1,633,852 of the mark "FREEDOM PHONE" for "telephones, answering machines, multi-station telephone key systems, telephone accessories, namely handset cords, line cords, adapters, wires, jack converters, jacks, face plates, wire junctions, couplers, filters, wire clips, backboards, antennae, message cassettes, beepers, and carrying cases."
- Reg. No. 1,832,059 of the mark "FREEDOMLINK" for "wireless telecommunications equipment, comprising a control unit, and hand sets that will allow the utilization of cellular frequencies."
- Reg. No. 1,875,862 for "FREEDOM LINK and design" as shown below, for "wireless telecommunications equipment comprising a control unit and handsets that will allow the utilization of cellular frequencies."

¹ Serial Number 75/133,153 filed on July 12, 1996 based upon an allegation of a *bona fide* intention to use the mark in commerce.

Freedom|Link , and

▪ Reg. No. 1,972,080 for "TOLL-FREEDOM" for "cellular telephone services."

As a result of its ownership of this collection of registrations, opposer alleges that applicant's mark, as used in connection with applicant's services, so resembles opposer's family of "FREEDOM ... " marks² comprising its individually pleaded registrations as to be likely to cause confusion or to cause mistake, or to deceive, within the meaning of Section 2(d) of the Lanham Act.

Applicant, in its answer, denied the salient allegations of likelihood of confusion.

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by opposer; certified copies of opposer's pleaded registrations, and applicant's responses to opposer's discovery devices, with related exhibits, introduced by way of opposer's notice of reliance. The record also includes the parties' stipulated protective order filed on November 2, 1998. Both opposer and applicant filed briefs on the case and an oral hearing was held.

² Opposer does not own a registration for the mark "FREEDOM" alone.

Opposer and its predecessors in interest have used various "FREEDOM ..." formative marks in connection with a wide variety of telephones and telephone accessories, supplies and equipment. Opposer itself sold telephone products under the "FREEDOM PHONE" mark beginning in 1984. Then in 1993, opposer entered into a long-term, exclusive licensing arrangement with Conair Corporation to market telephone instruments under the "FREEDOM PHONE" mark. Since that time, Conair has continued to sell a significant number of "FREEDOM PHONE" instruments. According to the confidential testimony of Randy Cole, opposer's employee who manages the contract with Conair, between 1993 and 1998, the retail sales volume of "FREEDOM PHONE" instruments has been in the range of five- to ten-million dollars *per month*. Although Conair was free under the terms of the license agreement to use this mark with or without other marks, Mr. Cole testified that Conair never used the mark "FREEDOM PHONE" alone, but rather always used "FREEDOM PHONE" in conjunction with the "Southwestern Bell" mark and the well-known Bell logo. The majority of promotional activities for these telephone instruments are undertaken by the local retailers - predominantly those associated with nation-wide chains of large discount stores.

In view of opposer's ownership of valid and subsisting registrations for its pleaded marks, there is no issue with

respect to opposer's priority. King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

In the course of rendering this decision under Section 2(d) of the Act, we have analyzed all of the probative factors in evidence consistent with the guidance of In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). This case sets forth the factors which, if relevant, should be considered in determining the issue of likelihood of confusion.

We begin our analysis by turning to the similarity or dissimilarity and nature of the services as recited in the application and the goods and services in connection with which opposer's prior mark is in use.

Opposer is well known as one of the former Bell companies, still relying upon "SOUTHWESTERN BELL" for many of its telecommunication goods and services. In this proceeding, four of the five claimed "FREEDOM ..." formative marks are used on telephone instruments and related telephone equipment. The newest registration ("TOLL-FREEDOM") is for cellular telephone services.

With respect to applicant's services, applicant's expands on its recital in the following manner:

Applicant has started a new business which provides free telephone service in the form of local outgoing calls limited to three minutes in duration. Applicant provides telephone booths which are freely accessibly located in public places, such as stores, bowling alleys, shopping

malls, movie theaters, etc. and there is no charge to the calling party, the called party, nor the site where the booth is located. No incoming calls can be received on these telephones and they will not accept credit cards. Revenue is raised by leasing advertising space on the interior walls of the booth with the expectation that caller will read the advertising during their three minute call. There are now more than 300 of these booths in operation.

The booths have three panels forming an enclosure opening to one side. The interior surfaces of the panels provide space for advertising to be placed and covered with protective shields. The advertising can range from business card size to the maximum size of the side panels. The exterior surface of each side panel carry (sic) the FREEFONE mark in large bold lettering.³

Inasmuch as the telephone booths do carry the FREEFONE mark in large bold lettering, applicant's mark will be seen by ordinary customers in the context of their taking advantage of the underlying telephone service. In fact, in its brief, applicant has accepted the fact that his advertising services are inextricably tied into the offering of telephone services. In this regard, applicant seems to treat this application as if it included a recital of "telecommunication services," and then repeatedly stresses the remarkable distinction that applicant is providing telecommunication services free of charge.

However, the exact recital of services in the application for registration is most critical, because any registration that issues will carry that precise recitation. See [Canadian](#)

³ Applicant's brief, pp. 1-2.

Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). The instant recital focuses specifically on advertising and rental services. Hence, when determining how similar or dissimilar are the goods and services herein, we are comparing opposer's claimed goods (primarily telephone equipment in International Class 9) and services (wireless telephone services) with applicant's advertising and rental services. In this case, we find that telephone equipment and services are not that closely related to applicant's advertising and rental services, in spite of the specified advertising medium.

In looking at the conditions under which and buyers to whom sales are made, a closely-related du Pont factor, we find that applicant's services would be directed to potential advertisers, who must be assumed to be fairly sophisticated consumers. These advertising and rental services are not targeted toward the ordinary consumer making a casual telephone call from one of applicant's 300 telephone booths.

Likewise, when one turns to the similarity or dissimilarity of established, likely-to-continue trade channels, applicant's advertising and rental services would clearly be found in different channels of trade than cellular telephone services or the equipment sold by opposer's licensee, so this du Pont factor also favors applicant.

We turn, then, to a discussion of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. From the dictionary entries of record, there seems to be no dispute that "FREEDOM" and "FREE" are related concepts, and that the words share the same etymology. However interesting that may be, etymological roots are hardly synonymous with identical, or even similar, meaning in contemporary English usage in the United States of America. In the context of this proceeding, when one compares applicant's "FREEFONE and design" mark with opposer's "FREEDOM PHONE," the marks are distinctly different as to appearance, sound, connotation and overall commercial impression. The additional syllable in opposer's mark is not insignificant when pronouncing these two marks. "FREEDOM PHONE" is much longer and is two distinct words. And the respective meanings imparted to the consumer are quite different. On this critical element, we agree with applicant that the word "freedom" as used in opposer's "FREEDOM PHONE" on telephone instruments and cellular telephone services has a very different connotation than the word "free..." as used in applicant's "FREEFONE and design" mark in conjunction with a service for placing advertisements on public telephones or telephone booths. Hence, we find the marks to be quite dissimilar.

Given the large volume of sales of "FREEDOM PHONE" instruments over the past fifteen years, we assume this mark has had an impact on the marketplace for telephone instruments, and this factor weighs in opposer's favor. However, applicant has pointed out that Conair always uses the mark "FREEDOM PHONE" in conjunction with the trade name (the Southwestern Bell house mark), and that right next to the well-known bell-in-a-circle logo (used jointly by all the former Bell companies). This supports a conclusion that "FREEDOM PHONE" alone is not strong enough to impart the critical goodwill consumers associate with equipment emanating from "the phone company." Indeed, one might argue the benefits of this exclusive license for Southwestern Bell and for Conair are closely tied to the use of these two latter well-known symbols rather than any magnetism emanating from the product mark, "FREEDOM PHONE," itself.

Decision: Accordingly, we determine that there is no likelihood of confusion, and the opposition is dismissed.

R. L. Simms

T. J. Quinn

D. E. Bucher

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Judges, Trademark Trial and
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